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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT Carl Joseph Kraenzel et al.
APPLICATION OF:
SERIAL NO.: 10/091,573
ATTORNEY 042846-0312968
DOCKET NO:
FILING DATE: March 7, 2002
ART UNIT : 3629
EXAMINER TAN D. NGUYEN
FOR: SYSTEM AND METHOD FOR IDENTIFYING SYNERGISTIC OPPORTUNITIES
 WITHIN AND BETWEEN ORGANIZATIONS

MAIL STOP APPEAL BRIEF – PATENTS

Commissioner for Patents
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REPLY BRIEF

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I. INTRODUCTION.

This Reply Brief is being filed within two months of the Examiner's Answer (hereinafter "Answer") mailed December 12, 2007. This Brief responds to the new points raised by the Examiner.

II. STATUS OF CLAIMS.

Pending claims 1, 2, 4-6, 8, 12, 14, 15, 17-19, 21, 25-27, 29-31, 33 and 37 stand rejected, and are on appeal. In the Answer, the Examiner reiterates the alleged rejections set forth in the Final Office Action mailed April 9, 2007 (hereinafter "Final Action"):

Claims 1, 2, 4-6, 8, 12, 14, 15, 17-19, 21, 25-27, 29-31, 33 and 37 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,960,173 to Tang *et al.* ("Tang") [Final Action, pg. 3, §4; and Answer, pg. 3, §4].

III. RESPONSE TO EXAMINER'S ARGUMENTS.

INDEPENDENT CLAIMS 1, 14 & 26.

1. Enabling one or more users to declare and associate.

The Examiner has Improperly Failed to Accord any Patentable Weight to the Recitation of "enabling one or more users to declare and associate."

The rejection of independent claims 1, 14 and 26 under 35 U.S.C. §103(a) over Tang is legally improper because the Examiner has improperly failed to accord any patentable weight to the recitation of "enabling one or more users to declare and associate" in independent claims 1, 14 and 26.

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Independent claims 1, 14 and 26 each generally recite, *inter alia*, that the system/method enabling one or more users to declare and associate information with topics including topic descriptions and keywords related to the declared topic. The declared topic and associated information are stored. Subsequent computing activities of users are monitored. If the system/method determines that a user appears interested in a declared topic, based on the monitored activities and the associated information, that user is notified of the existence of the declared topic.

Putting aside that the Answer is the first time this argument has been raised, the Examiner erroneously alleges that "the phrase 'enabling one or more users to declare and associate' is considered nonfunctional descriptive material about the 'information' and has no patentable weight." [Answer, pg. 4]. This is clear legal error! It is clear that the prior art does not disclose or teach this feature. Thus, recognizing this shortcoming, the Examiner improperly tries to infer that this feature does not count by wrongly characterizing the relevant claim recitations as nonfunctional descriptive material.

The case law relating to non-functional descriptive material is well established. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Moreover, the Board of Patent Appeals and Interferences ("Board") has identified common situations involving nonfunctional descriptive material, which include:

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- a computer-readable storage medium that differs from the prior art - solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

See, Ex parte Curry, 84 USPQ2d 1272 (Bd. Pat. App. & Int. 2005); Ex parte Mathias, 84 USPQ2d 1276 (Bd. Pat. App. & Int. 2005).

The recited aspects of declaring and associating are not merely descriptive of the 'information' as alleged by the Examiner, but are functional steps of the computer-implemented method of claim 1. Moreover, the recited aspects of declaring and associating are not within the above-listed examples provided by the Board since they are not nonfunctional descriptive material encoded on a computer-readable medium, descriptive material that does not reconfigure the computer, or descriptive material that does not alter the process steps of the recited method.

The acts of declaring and associating are functional actions included in the computer-implemented method of claim 1 to create topics, link related information together, and store such information for subsequent use by the method. Since the declaration and association of information with one or more topics are functionally related to the information and actions and not merely descriptive of the information as alleged by the Examiner, then the recitation of these aspects must be given patentable weight.

Furthermore, the Examiner's argument is legally flawed because "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. (BNA) 494, 496 (C.C.P.A. 1970). By admittedly

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failing to consider a positively-recited claim feature, the Examiner is ignoring well-established case law, and is clearly failing to consider the subject matter sought to be patented *as a whole*.

When viewing the claims as a whole, it is clear that enabling the user to declare and associate information with the declared topic, together with one or more of the other recited claim features, results in a system and method that is distinguishable from, and provides advantages over, existing systems and methods.

Further, the Examiner's argument is legally flawed because "[d]istilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.' *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In the Answer, the Examiner states:

[i]t appears that claim 1 is a computer-implemented method and wherein data/information is input in step (a) and stored in step (b) in a database, and based on the data/information of (b), carrying out steps (c) and (d). [Answer, page 4].

Thus, the Examiner has ignored the explicit claim recitations and has attempted to broadly redefine the invention without any regard to the claimed invention as a whole. This is clear legal error.

For *at least* these reasons, the Examiner has improperly failed to accord any patentable weight to the recitation of "enabling one or more users to declare and associate" in independent claims 1, 14 and 26. Thus, the rejection under 35 U.S.C. §103(a) is legally improper and must be reversed.

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2. The Examiner's assertion that Tang may inherently include the aspect of "enabling one or more users to declare and associate" is legal error.

The Examiner states:

In other words, [Tang] does not need to include this limitation even though it may be inherently included when the data of the user is stored in the database before being used by the "Encounter Server 141." [Answer, page 9].

This is legal error! "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). There is no disclosure, teaching or objective basis in the cited portions of Tang that would lead one to conclude that users of Tang are necessarily enabled to declare and associate information with one or more topics. Here, the Answer has failed to provide any such factual basis. In fact, the Answer admits that (at most) Tang may inherently include this aspect. There is no legal basis to say a reference may inherently do something. Either Tang necessarily includes this feature, or it does not. The Examiner's assertion regarding Tang illustrates it does not. Tang does not appear to rely on any overt actions by a user to declare topics, but rather appears to be a passive system relying upon computers running encounter-aware applications to determine task proximity. There is simply no basis in fact or law to support the Examiner's inherency determination.

For at least each of the foregoing reasons, Tang does not disclose, teach, or render obvious each of the features of at least independent claims 1, 14 and 26. Accordingly, the rejection under 35 U.S.C. §103(a) is improper and should be reversed. Dependent claims 2,

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4-6, 8, 12, 15, 17-19, 21, 25, 27, 29-31, 33 and 37 are allowable because they depend from allowable independent claims, as well as for the further features they recite.

CONCLUSION

Appellant now appeals to this Honorable Board to promptly reverse all rejections of claims 1, 2, 4-6, 8, 12, 14, 15, 17-19, 21, 25-27, 29-31, 33 and 37, and issue a Decision in favor of Appellant. All of the claims are in condition for allowance.

Date: February 12, 2008

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